REMARKS

This Amendment modifies the Request for Continued Examination (RCE) filed herewith. Applicant appreciates the Office's review of the present application. In response to the Office Action, the cited references have been reviewed, and the rejections and objections made to the claims by the Examiner have been considered. The claims presently on file in the present application are believed to be patentably distinguishable over the cited references, and therefore allowance of these claims is earnestly solicited.

In order to render the claims more clear and definite, and to emphasize the patentable novelty thereof, claims 1-4, 8-13, 15, 17-19, 21, and 23 have been amended, claims 14, 16, 22, and 24-25 have been cancelled without prejudice, and new claims 26-33 have been added. Support for any new claims is found in the specification, claims, and drawings as originally filed, and no new matter has been added. Accordingly, all claims presently on file in the subject application are in condition for immediate allowance, and such action is respectfully requested.

Rejections

Rejection Under 35USC § 112 Second Paragraph

Claims 2-4 and 8 have been rejected under 35 USC § 112, subparagraph 2, as being indefinite for failing to particularly point and distinctly claim the subject matter which the Applicant regards as the invention. In response, each of the Examiner's stated reasons have been addressed in the foregoing claim amendments and are briefly summarized below.

Claims 2-4 and 8 have been amended to remove recitation of the terms "first device" and "second device".

In view of the foregoing, it is submitted that the rejections under 35 USC § 112, paragraph 2, have been overcome and should be withdrawn.

Rejection Under 35USC § 103

Claims 1-4, 8-12, 15, 17, and 19 have been rejected under 35 USC § 103(a), as being unpatentable over U.S. patent 6,012,088 to Li et al. ("Li"). Applicants respectfully traverse the rejection and request reconsideration based on the amendment to claims 1-4, 8-12, 15, 17, and 19, and features in the claims which are neither disclosed nor suggested in the cited references, taken either alone or in combination.

As to a rejection under 103(a), the U.S. Patent and Trademark Office ("USPTO") has the burden under § 103 to establish a *prima facie* case of obviousness by showing some objective teaching in the prior art or generally available knowledge of one of ordinary skill in the art that would lead that individual to the claimed invention. *See In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988).* The Manual of Patent Examining Procedure (MPEP) section 2143 discusses the requirements of a *prima facie* case for obviousness. That section provides as follows:

> To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and reasonable expectation of success must be found in the prior art, and not based on applicant's disclosure.

In the present case, the Office has not established a *prima facie* case of obviousness at least because the applied references do not teach or suggest all of Applicant's claim limitations.

Independent claim 1 (amended), and its dependent claims 2-4 and 8, are patentably distinguishable over the cited references because claim 1 emphasizes the novel features of the present invention in which an unconfigured network device creates its own configuration information, including its own unique IP address, using the IP address and the subnet mask of a

single configured device sent over the network. In this regard, claim 1 recites:

"1. (Currently amended) A network configuration comprising:
one or more configured devices each of which comprises a server, hub, router, client or switch connected to the network, wherein <u>at least one of the configured devices is capable of sending over the network at least a portion of its configuration information including its IP address and its subnet mask</u>; and
an unconfigured device which comprises a server, hub, router, client, or switch connected to the network, wherein the unconfigured device is capable of <u>creating its own configuration information, including its own unique IP address, using the IP address and the subnet mask of a single one of the configured devices</u>." (emphasis added)

The Li reference describes automatic configuration of an Internet access device in which the Internet access the device downloads configuration data from a configuration server (Abstract). The configuration server has a unique configuration record for the Internet access device (col. 12, lines 45-47). "The configuration record contains information such as ... <u>the Internet access device IP address</u>" (col. 14, lines 56-58; emphasis added).

The features of the present invention are neither disclosed nor suggested by the Li reference in that the configuration server (i.e. the configured device) of the Li reference does not send over the network its own IP address (i.e. the IP address <u>of the configuration server</u>), but rather sends over the network the IP address <u>of the Internet access device</u> (i.e. the unconfigured device). As recited in claim 1, the unconfigured device is capable of creating its own unique IP address based in part on the IP address of the configured device. <u>Creating</u> an as-yet undetermined IP address for an unconfigured device from the IP address of a configured device is significantly different from merely <u>receiving</u> the unconfigured device's already-determined IP address from the configured device.

Accordingly, the features of the present invention are neither disclosed nor suggested by the Li reference. Applicant respectfully traverses the Office's assertion that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the claimed features of Applicant's invention. Such could be possible only in hindsight and in light of Applicant's teachings. Therefore, the rejection is improper at least for that reason and should

be withdrawn.

Applicant further wishes to discuss the impropriety of any prospective obviousness rejection based on the Li reference in view of U.S. patent 6,532,217 to Alkhatib et al. ("Alkhatib").

The unconfigured device of the Li reference, as discussed above, does not create its own IP address from the IP address of a configured device.

The Alkhatib reference teaches a system:

"for automatically determining a network address. A new node starting on the network will solicit addresses from other underlined nodes on the subnet. The addresses received are stored in a database. The address stored in the database will be reviewed in order to determine a subnet mask. The new node will choose a host number, based on the subnet mask, that is unique among the addresses in the database: The chosen unique host number is combined with the subnet number to form the new node's network address. (Abstract)

The Alkhatib reference solicits network addresses from a plurality of other network nodes. As part of the method (Fig. 3) of automatically assigning a network address, "device 76 determines whether a sufficient number of responses have been received (step 94). ... In one embodiment, the number of responses being deemed sufficient is at least two packets where the packets are from different nodes" (col. 7, lines 19-25). If a response is not received from a sufficient number of different nodes (i.e. the "No" branch of Fig. 3A, step 94), execution branches to step 90 to solicit additional active nodes.

Conversely, claim 1 recites that the unconfigured device is capable of creating its own unique IP address, using the IP address of only a single one of the configured devices.

Claim 1 also recites that a configured device is capable of sending over the network its subnet mask, and that the unconfigured device is capable of creating its own unique IP address using the IP address and the subnet mask of a single one of the configured devices.

The configured devices of the Alkhatib reference do not send their subnet masks over the network. Instead, the Alkhatib reference discloses a complex process to determine a subnet mask

for the unconfigured device in which a temporary subnet mask, which is then iteratively changed until an actual subnet mask can be determined, is derived from the IP addresses received from the plurality of nodes (Fig. 3A, steps 98-108; col. 7, line 37 – col. 11, line 45)

Accordingly, the features of the present invention are neither disclosed nor suggested by the Li and Alkhatib references, alone or in combination. Applicant believes it would not have been obvious to a person of ordinary skill in the art at the time the invention was made to include the claimed features of Applicant's invention. Such could be possible only in hindsight and in light of Applicant's teachings. Therefore, a rejection would be improper at least for that reason and should not be made.

Independent claims 9 (currently amended) and 30 (new) each recite limitations similar to those of claim 1, discussed above.

Claim 9 recites:

"9. (Currently amended) A computer-implemented method of configuring an unconfigured device connected to a network using configuration information of one configured device connected to the network, comprising:
sending over the network from the <u>one configured device</u> to the unconfigured device at least a portion of the configuration information of the configured device, the portion including <u>an IP address and a subnet mask of the configured device</u>, the IP address and the subnet mask of the configured device <u>usable by the unconfigured device to create configuration information including a unique IP address of the unconfigured device</u>." (emphasis added)

Claim 30 recites:

"30. (New) A computer-implemented method of configuring an unconfigured device connected to a network using configuration information of one configured device connected to the network, comprising:
receiving from the <u>one configured device</u> over the network at the unconfigured device at least a portion of the configuration information of the configured device, the portion including <u>an IP address and a subnet mask of the configured device</u>; and
using the IP address and the subnet mask of the configured device, <u>the unconfigured device creating configuration information for the unconfigured device including a unique IP address of the unconfigured device</u>." (emphasis added)

For similar reasons as explained heretofore with regard to claim 1, the features of the present invention are not taught or suggested by the Li and Alkhatib references, alone or in combination.

Applicant respectfully traverses the Office's assertion that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the claimed features of Applicants' invention. Such could be possible only in hindsight and in light of Applicants' teachings. Therefore, the rejection of independent claims 9 and 30, and dependent claims 2-4, 8, 10-12, 15, 17, and 19, is improper at least for these reasons and should be withdrawn.

Claim 13 has been rejected under 35 USC § 103 (a), as being unpatentable over U.S. patent 6,012,088 to Li et al. ("Li") in view of U.S. patent 6,629,145 to Pham et al. ("Pham"). Applicants respectfully traverse the rejection and request reconsideration based on the dependence of this claim on newly-added independent claim 30, whose reasons for allowability over a prospective rejection based on the Li reference and the Alkhatib reference, alone or in combination, have been discussed heretofore.

Claim 18 has been rejected under 35 USC § 103 (a), as being unpatentable over U.S. patent 6,012,088 to Li et al. ("Li") in view of U.S. patent 6,603,758 to Schmuelling et al. ("Schmuelling"). Applicants respectfully traverse the rejection and request reconsideration based on the dependence of this claim on independent claim 9, whose reasons for allowability over the Li reference have been discussed heretofore and against which the Schmuelling reference has not been cited.

Claim 21 has been rejected under 35 USC § 103 (a), as being unpatentable over U.S. patent 6,012,088 to Li et al. ("Li") in view of U.S. patent 6,532,217 to Alkhatib et al. ("Alkhatib"). Applicants respectfully traverse the rejection and request reconsideration based on

the dependence of this claim on newly-added independent claim 30, whose reasons for allowability over a prospective rejection based on the Li reference and the Alkhatib reference, alone or in combination, have been discussed heretofore.

Claim 23 has been rejected under 35 USC § 103 (a), as being unpatentable over U.S. patent 6,012,088 to Li et al. ("Li") in view of U.S. patent 6,687,755 to Ford et al. ("Ford"). Applicants respectfully traverse the rejection and request reconsideration based on the dependence of this claim on newly-added independent claim 30, whose reasons for allowability over a prospective rejection based on the Li reference and the Alkhatib reference, alone or in combination, have been discussed heretofore.
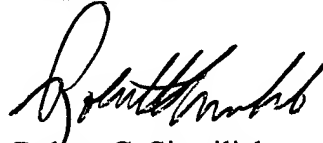
Conclusion

Attorney for Applicant(s) has carefully reviewed each one of the cited references made of record and not relied upon, and believes that the claims presently on file in the subject application patentably distinguish thereover, either taken alone or in combination with one another.

Therefore, all claims presently on file in the subject application are in condition for immediate allowance, and such action is respectfully requested. If it is felt for any reason that direct communication with Applicant's attorney would serve to advance prosecution of this case to finality, the Examiner is invited to call the undersigned Robert C. Sismilich, Esq. at the below-listed telephone number.

AUTHORIZATION TO PAY AND PETITION
FOR THE ACCEPTANCE OF ANY NECESSARY FEES

If any charges or fees must be paid in connection with the foregoing communication (including but not limited to the payment of an extension fee or issue fees), or if any overpayment is to be refunded in connection with the above-identified application, any such charges or fees, or any such overpayment, may be respectively paid out of, or into, the Deposit Account No. 08-2025 of Hewlett-Packard Company. If any such payment also requires Petition or Extension Request, please construe this authorization to pay as the necessary Petition or Request which is required to accompany the payment.

Respectfully submitted,

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